

ESTTA Tracking number: **ESTTA718055**

Filing date: **01/04/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91224533
Party	Defendant Dazzle Up, LLC
Correspondence Address	DAVID W. SAR BROOKS, PIERCE, MCLENDON, HUMPHREY & LEO PO BOX 26000 GREENSBORO, NC 27420-6000 rcage@brookspierce.com
Submission	Answer and Counterclaim
Filer's Name	David W. Sar
Filer's e-mail	dsar@brookspierce.com
Signature	/DavidWSar/
Date	01/04/2016
Attachments	Amended_Answer_and_Counterclaim.pdf(52291 bytes)

Registration Subject to the filing

Registration No	3335887	Registration date	11/13/2007
Registrant	SIMPLY SOUTHERN FINE ART AND HOME DÑ#COR, LLC 5 CHEROKEE LANE COVINGTON, LA 70433 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 035. First Use: 2004/02/23 First Use In Commerce: 2004/02/24

All goods and services in the class are requested, namely: Retail and computerized online ordering-services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wallshelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals

)	
SIMPLY SOUTHERN FINE ARTS)	
AND HOME DÉCOR, LLC,)	Opposition No. 91224533
Opposer/Registrant,)	Application Serial No. 86/450,713
)	
v.)	Counterclaim Cancellation Petition
)	Registration No. 3,335,887
DAZZLE UP, LLC,)	
Applicant/Counterclaim)	
Petitioner.)	
)	

Dazzle Up, LLC (“Applicant”), by and through undersigned counsel, and pursuant to 37 C.F.R. § 2.107 and TBMP §§ 313 & 315, hereby provides its amended answer and response to the Notice of Opposition (the “Notice”) of Simply Southern Fine Arts and Home Décor, LLC (“Opposer”) and its counterclaim/petition to cancel as follows:

FIRST DEFENSE
(Answer to Allegations of Notice of Opposition)

1. Applicant lacks information or knowledge sufficient to form a belief as to the allegations contained in paragraph 1 of the Notice, and therefore denies the same.
2. Responding to the allegations of paragraph 2 of the Notice, it is admitted that the records of the United States Patent and Trademark Office (“USPTO”) reflect some of the

information alleged in paragraph 2 of the Notice, such as the referenced trademark registration, the recited goods, and the last listed owner of such registration. Except as expressly admitted, Applicant lacks information or knowledge sufficient to form a belief as to the allegations contained in paragraph 2 of the Notice, and therefore denies the same.

3. Applicant lacks information or knowledge sufficient to form a belief as to the allegations contained in paragraph 3 of the Notice, and therefore denies the same.

4. Responding to the allegations of paragraph 4 of the Notice, it is admitted that on November 11, 2014, Applicant filed trademark application Serial No. 86/450,713 (the “Application”). To the extent that paragraph 4 of the Notice alleges that a copy of the Application is attached to the Notice as Exhibit A, such allegation is denied. Except as expressly admitted, Applicant lacks information or knowledge sufficient to form a belief as to the allegations contained in paragraph 4 of the Notice, and therefore denies the same.

5. Applicant denies the allegations contained in paragraph 5 of the Notice.

6. Responding to the allegations of paragraph 6 of the Notice, Applicant admits that that Opposer has not informed Applicant that it has granted any trademark rights to Applicant; that Applicant is not affiliated with, connected with, endorsed by, or sponsored by Opposer; and that Opposer has not informed Applicant that it has approved any of the goods offered or sold, or intended to be sold by Applicant under the Opposed Mark. Except as expressly admitted, Applicant denies the allegations in paragraph 6 of the Notice.

7. Responding to the allegations of paragraph 7 of the Notice, Applicant admits that the mark for which registration is sought through its application Serial No. 86/450,713 is SIMPLY SOUTHERN. Except as expressly admitted, Applicant denies the allegations contained in paragraph 7 of the Notice.

8. Applicant denies the allegations contained in paragraph 8 of the Notice.
9. Applicant denies the allegations contained in paragraph 9 of the Notice.
10. Applicant denies the allegations contained in paragraph 10 of the Notice.
11. Applicant denies the allegations contained in paragraph 11 of the Notice.

With respect to Opposer's prayer for relief, Applicant expressly denies Opposer is entitled to any relief.

ADDITIONAL DEFENSES/RESPONSES

Applicant asserts the following additional defenses or responses to the Notice. The fact of an assertion below and herein does not amount to an admission or a denial that the matter set forth is properly characterized as an affirmative defense as opposed to a specific denial of a matter for which the Opposer bears the burden of proof, as such a determination is a matter of law for the Board. Applicant reserves the right to, and may assert any and all other valid defenses and/counterclaims that may be learned of or developed through discovery and/or testimony in this proceeding.

SECOND DEFENSE (Failure to State a Claim—Fed. R. Civ. P. 12(b)(6))

The allegations asserted in the Notice fail to state a claim upon which relief can be granted against Applicant in this proceeding and should be dismissed.

THIRD DEFENSE (No Likelihood of Confusion)

The goods recited in the Application are different from the retail and computerized online ordering services identified in United States trademark registration No. 3,335,887 and other goods/services with which Opposer alleges that it has used its alleged mark and on which it bases this Opposition, and there is no likelihood of confusion.

FOURTH DEFENSE
(Different Marks; Lack of Prior Rights)

Upon information and belief, the name and mark purportedly used by Opposer, if any, is Simply Southern Fine Art and Home Décor or Simply Southern Fine Arts and Home Décor, not Simply Southern. Upon information and belief, Opposer cannot establish prior use and/or prior rights as compared to Applicant with respect to any allegedly confusingly similar mark, or a likelihood of confusion with a mark it has purportedly used. To the extent Opposer has commenced using the two-word phrase Simply Southern, it has done so after Applicant established its rights and/or use of SIMPLY SOUTHERN.

FIFTH DEFENSE
(Abandonment)

Upon information and belief, United States trademark registration No. 3,335,887 was abandoned and thus is not a proper basis on which to oppose the application.

SIXTH DEFENSE
(Opposer Owns No Rights in the Cited Registration)

Upon information and belief, United States trademark registration No. 3,335,887 was abandoned prior to the purported assignment of which Opposer apparently claims the benefit. Consequently, the purported assignment of which Opposer apparently claims the benefit was invalid, Opposer owns no valid trademark rights to United States trademark registration No. 3,335,887, and United States trademark registration No. 3,335,887 is not a proper basis on which to oppose the application.

SEVENTH DEFENSE
(Different Parties; No Rights)

Opposer identifies itself in the Notice as Simply Southern Fine Arts and Home Décor, LLC (with an “s” at the end of “Art”). That entity, to the extent it exists, is not the assignee of

United States trademark registration No. 3,335,887, nor is it the last listed owner of United States trademark registration No. 3,335,887, according to United States Patent and Trademark Office's on-line records. The assignment available through the United States Patent and Trademark Office's on-line records indicates that United States trademark registration No. 3,335,887 was assigned to Simply Southern Fine Art and Home Décor, LLC (without an "s" at the end of "Art"). To the extent the Opposer has properly identified itself (with an "s" at the end of "Art"), it owns no rights in United States trademark registration No. 3,335,887, and, upon information and belief, also holds no other rights in the names in question, and its opposition should be dismissed.

WHEREFORE, Applicant requests that the Notice of Opposition proceeding be dismissed with prejudice and that Applicant's application be allowed to mature to registration.

COUNTERCLAIM

Dazzle Up, LLC, a limited liability company organized and existing under the laws of the State of North Carolina, with a principal place of business located at 4300 Waterleaf Ct., Greensboro, North Carolina 27410 (hereinafter "Applicant", "Petitioner" or "Dazzle Up"), believes it has been or will be damaged by the existence of Registration No. 3,335,887 for SIMPLY SOUTHERN (the "Registration"), is also the applicant for application Serial No. 86/450,713 which has been opposed on the basis, in part, of the Registration, and hereby asserts a counterclaim petitioning for the cancellation of the Registration, by and through counsel, pursuant to 15 U.S.C. § 1064(3) and TBMP § 313.

The grounds for this cancellation counterclaim are as follows:

1. Dazzle Up is a limited liability company organized and existing under the laws of the State of North Carolina, with a principal place of business located at 4300 Waterleaf Ct., Greensboro, North Carolina 27410.

2. Dazzle Up is the applicant for application Serial No. 86/450,713 which has been opposed by Simply Southern Fine Arts and Home Décor, LLC (“Opposer”) on the basis, in part, of the Registration.

3. Opposer has alleged in its Notice of Opposition that it is a limited liability company formed under the laws of the State of Louisiana. Upon information and belief, Opposer has mis-identified itself.

4. Opposer claims ownership of the Registration in its Notice of Opposition. Opposer cites the Registration as a basis, in part, for its opposition to Dazzle Up’s application Serial No. 86/450,713.

5. Upon information and belief, Simply Southern Fine Art and Home Décor, LLC (“SSFAHD”) is a limited liability company organized and existing under the laws of the State of Louisiana.

6. SSFAHD is the last listed owner of record for the Registration shown on the on-line TSDR records of the United States Patent and Trademark Office.

7. As shown on the on-line records of the United States Patent and Trademark Office, SSFAHD was purportedly assigned the Registration on May 19, 2015.

8. Opposer requested an extension of time to file its Notice of Opposition on May 26, 2015.

9. The Registration - No. 3,335,887 - is for the mark SIMPLY SOUTHERN for “Retail and computerized online ordering services featuring home furnishings, wall accessories,

candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals,” in international class 035.

10. As reflected by the on-line records of the United States Patent and Trademark Office, the most recent prior owner of the Registration was Lawrence Taylor (“Taylor”), an individual who provided an address in Melbourne, Florida.

11. Upon information and belief, Taylor, or another prior owner of the Registration, ceased using with no intention to resume use of, and otherwise abandoned, the use of SIMPLY SOUTHERN for all, or some, of “Retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals.”

12. Upon information and belief, Taylor, or another prior owner of the Registration, failed to use SIMPLY SOUTHERN for all, or some, of “Retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals,” for at least three consecutive years.

13. The Registration was abandoned, in part or in whole, within the meaning of 15 U.S.C. § 1064(3) & 1127.

14. The Registration should therefore be cancelled, in part or in whole, due to abandonment.

15. Dazzle Up has been damaged and will continue to be damaged if the Registration is permitted to remain on the Principal Register, including because the Registration has been cited by Opposer as a basis for its opposition to Dazzle Up's application Serial No. 86/450,713.

WHEREFORE, Petitioner respectfully requests that this counterclaim/petition be sustained and that Registration No. 3,335,887 be cancelled, and also that Opposer's Notice of Opposition proceeding be dismissed with prejudice and that Applicant's application be allowed to mature to registration.

Please recognize as an attorney for Applicant/counterclaim petitioner in this proceeding, David W. Sar, and the law firm of Brooks, Pierce, McLendon, Humphrey & Leonard, LLP, P.O. Box 26000, Greensboro, North Carolina 27420, dsar@brookspierce.com.

Respectfully submitted this the 4th day of January, 2016.

/David W. Sar/
David W. Sar
N.C. State Bar No. 23533
dsar@brookspierce.com

BROOKS, PIERCE, McLENDON
HUMPHREY & LEONARD, LLP
P.O. Box 26000
Greensboro, NC 27420
Telephone: 336-373-8850
Facsimile: 336-378-1001
Attorneys for Dazzle Up, LLC

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Applicant's Amended Answer to Notice of Opposition and Counterclaim has been served on Opposer (via its counsel) by mailing said copy on January 4, 2016 via e-mail and First Class Mail, postage prepaid, and addressed as follows:

Warner J. Delaune
Baker Donelson Bearman Caldwell & Berkowitz, P.C.
450 Laurel Street
Chase North Tower, 20th Floor
Baton Rouge, LA 70801
wdelaune@bakerdonelson.com

/David W. Sar/
David W. Sar
N.C. State Bar No. 23533
dsar@brookspierce.com

BROOKS, PIERCE, McLENDON
HUMPHREY & LEONARD, LLP
P.O. Box 26000
Greensboro, NC 27420
Telephone: 336-373-8850
Facsimile: 336-378-1001
Attorneys for Dazzle Up, LLC